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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,049	01/15/2002	Monika Oswald	218230US0X	2944

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EXAMINER
STEIN, STEPHEN J

ART UNIT	PAPER NUMBER
1775	

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,049

Applicant(s)

OSWALD ET AL.

Examiner

Stephen J Stein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on December 22, 2001. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that for related claims group I and II (product and process of making), the office has not provided any evidence that the article could be made by the alternative method proposed and further that the office has failed to establish why it is a materially different method. With regard to related claims Group I and III (product and product of use), applicants argue that the office has not provided any reasons/and or examples supporting the proposed alternative method of use. Applicants further argue that the office has failed to establish why the proposed different method of use is materially different method than that claimed. With regard to related claims Group II and III, (combination – sub combination) applicants argue that the office has not provided any reasons/and or examples to support the assertion that the combination does not require the particulars of the sub combination and the sub combination as separate utility. With regard to unrelated claims Groups II and IV (unrelated inventions), applicants argue that that the office has not asserted any reasons and or examples to support the conclusion that the claims are unrelated. Applicants finally argue that a search of the claims would not constitute a serious burden and the restriction requirement should be withdrawn.

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This is not found persuasive because with regard to the arguments as to related claims groups (I and II) and (I and III), the office has asserted an alternative materially different method of manufacture and an alternative materially different method of use. Applicants have provided no argument as to why the proposed alternative method of manufacture and the proposed alternative use suggested by the office would not produce the claimed article or be a valid alternative method of use of the article. Applicants further have made no argument as to why the proposed alternatives are not materially different.

With regard to the argument as to related claims II and III, applicants' argument that the office has not provided any reasons supporting the assertion that the combination does not require the particulars of the sub combination and the sub combination as separate utility is without merit. In the restriction requirement, the office has asserted that the combination does not require the proportion of powder claimed in the combination and that the sub combination has separate utility such as a material to make free standing ceramic body. Therefore, the office has provided reasons supporting the assertion. Applicants have not argued why the reasons provided by the office are not valid.

With regard to the argument as to unrelated groups II and III, the argument that the office has not asserted any reasons and or examples to support the conclusion that the claims are unrelated is without merit. In the restriction requirement, the office has asserted that the claims are unrelated because they are not useable together since Group II is directed to preparing a layer, while Group III is directed to a composition. Since the composition (dispersion) is not required for the layer and is not recited in the method, the groups are unrelated. Applicants have made no argument as to why this assertion is improper.

With regard to applicants' final argument that the office has not met the burden requirement, the MPEP states that for purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. Since the office has shown a separate classification of the groups, a prima facie burden has been shown.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claims 4 and 5 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend another multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 4 and 5 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 2 and 3 recite the limitation "the layer is between 100 nm and 1mm, preferably between 1 µm and 50 µm, particularly between 5 µm and 15 µm". This limitation makes the claims indefinite because the scope of protection being sought by the claims is unclear. It is suggested that any preferable limitations be placed in subsequent dependent claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,672,330 (Hartmann et al.).

Hartmann discloses a flame-hydrolytically produced mixed oxide comprising titanium dioxide and silicon dioxide where the BET surface area of the mixed oxide is between 10 to 50 m²/g (col. 1, lines 38-42). Hartmann further discloses that the titanium dioxide mixed oxide can be used in the production of automobile paints (e.g. as part of a layer on a substrate) (col. 2, lines 14-18). With regard to the process limitations recited in the claims, process limitations in product claims are generally not dispositive on patentability unless it is shown that the process limitations produce a materially different product. MPEP §2113.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartmann et al.

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As stated above, Hartmann discloses a layer of a mixed oxide comprising titanium dioxide and silicon dioxide where the BET surface area of the mixed oxide is between 10 to 50 m²/g (col. 1, lines 38-42). Hartmann is silent on the thickness of the mixed oxide layer.

Absent a showing of criticality with respect to thickness (a result effective variable), it would have been obvious to a person of ordinary skill in the art at the time of the invention to adjust the thickness through routine experimentation in order to achieve varying hardness of the coating. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Stein whose telephone number is (703) 305-0583. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If the attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing (703) 308-3822. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose phone number is (703) 308-0661. The fax phone number for this group is (703) 872-9310 for non-final responses and (703) 872-9311 for after final responses.

January 3, 2003


Stephen J. Stein